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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,462	07/13/2001	Avi Ashkenazi	PRO229 POLYPEPTIDES	5591

35489 7590 08/05/2003

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EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
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1646

17

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,462

Applicant(s)

ASHKENAZI ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-46, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 44-46, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1646

DETAILED OFFICE ACTION

Applicant's amendment in paper No. 14, filed on 11 March 2003 is acknowledged and entered. Following the amendment, claims 39-43, 47, 48 and 49 are canceled, and claims 44-46 and 50 are amended.

Currently, claims 44-46, 50 and 51 are pending and under consideration.

Withdrawal of Objections and Rejections:

All objections and rejections of claims 39-43, 47, 48 and 49 are moot as the applicant has canceled the claims.

The objection of the specification is withdrawn in view of applicant's amendment.

The objection of claims 44 is withdrawn in view of applicant's amendment.

The rejection of claims 44-46, 50 and 51 under 35 U.S.C. 101, and 35 U.S.C. 112, first paragraph for lack of utility is withdrawn in view of applicant's argument, as the activity of inducing chondrocyte re-differentiation (Example 95) of the claimed polypeptide is sufficient to establish a credible, substantial, and specific utility.

The scope rejection, and the rejection for lack of written description of claims 44-46, 50 and 51 under 35 U.S.C. 112, first paragraph is withdrawn in view of applicant's amendment.

The rejection of claims 44-46, 50 and 51 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in view of applicant's amendment.

The prior art rejection of claims 44-46, 50 and 51 under 35 U.S.C. 102(b) as being anticipated by Wood et al., WO 99/14328 is withdrawn as the utility rejection is withdrawn, and such utility was established in the priority application PCT/US00/04414, filed on 2/22/00.

Rejections Over Prior Art:

The following rejections under 35 U.S.C. §§ 102 and 103 are made in view of determination that the effective filing date for the instantly claimed invention is 22 February 2000, which is the filing date of the priority application PCT/US00/04414.

Art Unit: 1646

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 44-46, 50 and 51 are rejected under 35 U.S.C. 102(a) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gebe et al., WO 98/39443 (11 September 1998).

The teachings of Gebe are reviewed in the last Office Action (paper No. 12), on pages 9-10. Briefly, Gebe discloses an amino acid sequence of a human Sp α polypeptide (Figure 1A-B), which has 347 amino acid residues, and comprises amino acid residues 1-346 of SEQ ID NO:148 (347 amino acids) of the instant claims with 100% sequence identity. The only difference in sequence between the two polypeptides is a single mismatch at the C-terminal end, position 347, wherein amino acid 347 of the prior art sequence is a Gly, which DNA codon is GGX; whereas amino acid 347 of the present SEQ ID NO:148 is a Val, which DNA codon is GTX. Therefore, the difference in a single nucleotide, the second nucleotide of the codon is responsible for the difference in amino acid 347. As such, it raises a question of a possible sequencing error on the mismatched nucleotide, which is a routine and an acceptable doubt in the art, and the examiner is

Art Unit: 1646

unable to determine whether the difference between sequences of the prior art and the instant SEQ ID NO 148 is real, and whether the instant claims are anticipated or are made obvious over the prior art. The burden shifts to the applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. Note the case law of *In re Best* 195 USPQ 430, 433 (CCPA 1977).

Conclusion:

No claim is allowed.

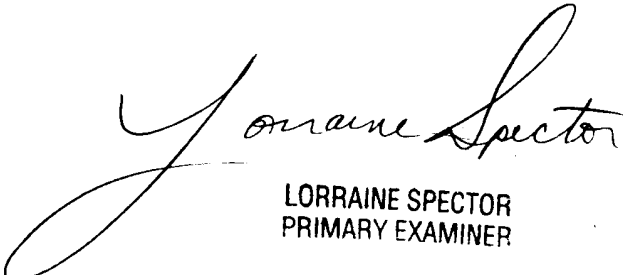
Art Unit: 1646

Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



LORRAINE SPECTOR
PRIMARY EXAMINER

Dong Jiang, Ph.D.
Patent Examiner
AU1646
7/31/03